

REMARKS

The Official Action dated May 31, 2005 has been carefully considered. It is believed that the present Amendment places the present application in condition for allowance. Reconsideration is respectfully requested.

By the present Amendment, the preamble of the claims has been amended to recite a radiation cured encapsulating material as set forth in the specification, for example, at page 1, lines 2-4. Claims 51 and 52 have been added, support for which may be found in original claims 29, 42 and 43. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested.

In the Official Action, claims 29-50 were rejected under 35 U.S.C. §112, first paragraph, on the basis that the specification, while enabling for a radiation cured encapsulating material, does not provide enablement for a radiation cured material.

This rejection is traversed. However, to expedite prosecution, Applicants have revised claims 29-50 to recite a radiation cured encapsulating material. In view of the present specification, it should be understood that encapsulating refers to the covering of a surface material, thereby providing an adhesion force to an underlying surface material of greater than about 0.0044 pounds force, as recited in claims 29 and 51. It is therefore believed that claims 29-52 are fully enabled by the present specification, particularly as the Examiner has acknowledged that the specification is enabling for a radiation cured encapsulating material. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, has been overcome. Reconsideration is respectfully requested.

Claims 29-50 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the Szum U.S. Patent No. 6,240,230. The Examiner has asserted that Szum sets forth compositions that are substantially the same as or similar to that contemplated by Applicants' claims, whereby the compositions taught by

Szum necessarily result in the claimed tear strength and adhesion force. While Applicants argued that Szum's exemplary compositions are not identical to Applicants' exemplary compositions exhibiting the properties set forth in claim 29, the Examiner responded that Applicants' exemplary compositions are not recited in the claims and Szum is not limited solely to its preferred embodiments. Additionally, while Applicants argued that Szum teaches a composition having a significantly different modulus than that presently claimed, the Examiner asserted that Szum teaches his composition can have a modulus within Applicants' claimed range, referring to column 13, line 66.

This rejection is traversed and reconsideration is respectfully requested. Applicants submit that the radiation cured encapsulating materials as defined by the claims are neither anticipated by nor rendered obvious over Szum.

More particularly, independent claim 29 recites a radiation cured encapsulating material having a tear resistance of less than about 2.20 pounds force and an adhesion force to an underlying surface material of greater than about 0.0044 pounds force. Independent claim 51 recites a similar radiation cured encapsulating material, but further specifies that the material has a modulus at 25°C of from about 3000 to about 50,000 psi.

As noted in Applicants' previous response, Szum broadly discloses radiation curable compositions comprising 20 weight percent to about 80 weight percent of at least one urethane acrylate oligomer, about 20 weight percent to about 80 weight percent of at least one monomer diluent, and an effective amount of at least one photoinitiator. Szum specifically discloses that mechanical properties of the compositions and materials are effected by the selection of oligomer and by selection of reactive or monomer diluent (column 7, lines 1-3).

Szum provides no teaching or suggestion as to the tear resistance or adhesion force to an underlying surface material exhibited by the compositions. The Examiner asserted that a composition that is substantially the same as or similar to that contemplated by Applicants in

claims 33-38 necessarily results in the requisite tear strength and adhesion force, whereby the compositions disclosed by Szum inherently exhibit the tear resistance and adhesion force recited in claims 29 and 51. The Examiner cited *In re Spada*, 15 U.S.P.Q. 2d 1655 (Fed. Cir. 1990) in the first Official Action to support this assertion.

However, in finding anticipation of the Spada claims by a prior art reference, the Federal Circuit specifically compared the exemplary teachings of the prior art Smith reference with the exemplary teachings of Spada to find that the prior art Smith reference disclosed polymers identical to those of Spada before assuming that the properties claimed by Spada would be inherent in the prior art reference product. See, for example, Spada at pages 1656-1657. The Court in Spada correctly noted that rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all of the elements of the claimed invention be described in a single reference, and that the reference must describe the Applicants' claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it, 15 U.S.P.Q. 2d 1657. In this regard, a prior art disclosure of a generic composition encompassing a vast number of compositions, including an Applicant's claimed compositions, does not by itself describe the Applicant's claimed compositions in the meaning of 35 U.S.C. §102; rather, such prior art reference must further provide a more specific limited teaching relating to the claimed compositions in order to anticipate the same, *In re Petering*, 133 U.S.P.Q. 275 (C.C.P.A. 1962); *In re Ruschig*, 145 U.S.P.Q. 274 (C.C.P.A. 1965); *In re Arkley*, 172 U.S.P.Q. 524 (C.C.P.A. 1972). In view of the failure of Szum to more specifically disclose a composition along the lines of those exemplified in the present application as exhibiting a tear resistance and an adhesion force as recited in claim 29 and claim 51, the Examiner has no basis to assert that the teachings of Szum inherently exhibit the properties presently claimed and anticipate the claimed materials.

To the contrary, the exemplary teachings of Szum disclose compositions which are significantly distinguishable from those exemplified in the present application. While the teachings of a reference are not limited to examples, the Examiner's assertion of inherency must surely be limited to the examples, as the broad teachings of Szum cannot support any anticipation rejection under 35 U.S.C. §102. Moreover, while independent claims 29 and 51 are not limited to the compositions of examples 1 and 2 set forth in the present specification, Applicants have presented these examples as exemplary of materials exhibiting the properties recited in claims 29 and 51, and the failure of Szum to teach such compositions demonstrates the failure of Szum to inherently disclose compositions exhibiting the combination of properties required by the present claims.

Further, as noted in Applicants' previous response, the compositions of examples 1 and 3 of Szum have a modulus of approximately 140,000 psi and 107,000 psi respectively (1MPa = 145 psi). In contrast, claim 51 recites a radiation cured encapsulating material having a modulus of 25°C from about 3000 to about 50,000 psi. While Szum discloses that the compositions can be tailored to serve as single coatings if allowance is made for the coating to be soft enough, e.g., having a modulus of less than about 2000 psi, Applicants fail to find any teaching by Szum relating to a radiation cured encapsulated material having a modulus as recited in claim 51, in combination with the tear resistance and adhesion force required by claim 51. Similarly, while Szum broadly discloses that rubbery modulus values can be at least about 8 MPa, preferably greater than about 15 MPa and more preferably greater than about 25 MPa, Applicants find no teaching or suggestion by Szum relating to a radiation cured material having a modulus in the specific range recited in claim 51 in combination with the tear resistance and adhesion force properties further recited in claim 51. Thus, the teachings of Szum are further deficient.

With respect to claims 31, 32, 42, 43 and 48, the Examiner noted that Szum teaches that proper modulus is important and can be at least about 8 MPa to greater than 25 MPa and the composition can be tailored for different utilities with the modulus adjusted accordingly. The Examiner concluded it would have obvious to form a radiation cured material of the type contemplated by the claims, including claims 29-50, motivated by the teachings of Szum. However, Applicants find no teaching or suggestion in the broad teachings of Szum for one of ordinary skill in the art to prepare a radiation cured encapsulating material as presently claimed, having a combination of tear resistance and adhesion force as recited in claim 29 or a combination of tear resistance, adhesion force and modulus as recited in claim 51. Particularly, Applicants find no motivation for selecting among the broad teachings of Szum those features necessary to provide radiation cured encapsulating materials as defined by claims 29 and 51.

In order to render a claimed invention obvious, the prior art must enable one skilled in the art to make and use the claimed invention, *Motorola, Inc. v. InterDigital Tech. Corp.*, 43 U.S.P.Q.2d 1481, 1489 (Fed. Circ. 1997). In view of the deficiencies in the teachings of Szum discussed in detail above, Szum does not enable one skilled in the art to make and use a radiation cured encapsulating material having the combination of properties required by claim 29 or claim 51. Thus, Szum does not render the presently claimed materials obvious.

It is therefore submitted that the claimed radiation cured encapsulating materials are neither anticipated by nor rendered obvious over Szum, whereby the rejections under 35 U.S.C. §§102 or 103 have been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the rejections set forth in the Official Action, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Holly D. Kozlowski", written over a horizontal line.

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